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Supreme Court, U. S.
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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1972

NO. 72-678

SHERMAN FORD, JR., d/b/a
Ford Records,

Petitioner,

- against -

FORD MOTOR COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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November 1, 1972

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PETITION FOR A WRIT OF CERTIORARI
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AND PATENT APPEALS

The petitioner Sherman Ford, Jr., respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Customs and Patent Appeals entered in this proceeding on August 3, 1972.

CITATIONS TO OPINIONS BELOW

The decision of the Trademark Trial and Appeal Board dismissing the opposition is reported at 162 U.S.P.Q. 418 (1969), and is annexed to the petition as Appendix A. The decision of the United States Court of Customs and Patent Appeals reversing the decision of the Trademark Trial and Appeal Board is reported at 462 F.2d 1405, 59 C.C.P.A. , 174 U.S.P.Q. 456 (August 3, 1972), and is annexed to the petition as Appendix B.

JURISDICTIONAL STATEMENT

The decision of the United States Court of Customs and Patent Appeals for which review is sought is dated August 3, 1972 and was entered the same day. Petitioner invokes the jurisdiction of this Court pursuant to 28 U.S.C. §1256.

STATUTE INVOLVED

Lanham Act §2(d), 15 U.S.C. §1502(d):

> "No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
>
> * * *

"(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That when the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; or (ii) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (iii) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such mark is registered to the respective persons."

QUESTION PRESENTED

May respondent Ford Motor Company prevent petitioner Sherman Ford from registering a trademark, FORD RECORDS, which incorporates petitioner's surname,

for phonograph records and recording tapes on the grounds that the use of said trademark would cause confusion, where:

-- respondent has not registered the trademark FORD RECORDS for phonograph records;

-- petitioner is the prior user of the mark FORD RECORDS on phonograph records; and

-- respondent's training records bearing the trade name FORD MOTOR COMPANY and the trademark "RCA Victor", "Columbia Records" etc. are distributed exclusively for training automobile salesmen or mechanics?

STATEMENT OF THE CASE

In 1958 petitioner, Sherman Ford organized his own company to produce and market phonograph records. Continuously since that time he has used a design based upon his own surname on all foreign and domestic releases. This mark consists of the word "FORD" in block script with the 'O' replaced by a representation of a phonograph record, and with the word "RECORDS" in smaller print below. This distinctive trademark, which was designed by cartoonist Robert Vittur, is reproduced below:

Since the founding of his company, petitioner has produced approximately 50 45 RPM, 7-inch, single records and 30 33-1/3 RPM, 12-inch long-playing albums, of which 30 singles and 6 albums were released for sale. He has sold, offered for sale, or actively attempted to sell phonograph records and tape recordings as a business venture with a profit motive in each year since the founding of his company. He has consistently leased and attempted to lease master tape recordings, and has tape cartridges now in production.

Petitioner has recorded and produced records of instrumental and vocal music including rock and roll and standard popular material as well as folk and country and western music and opera. His records are of the usual commercial sizes and are designed to sell at standard retail prices. These records, like those of all standard commercial record manufacturers, are marketed through distributors who send or take the new releases to radio or television stations where they are played by disc jockeys, thereby stimulating retail sales. They are sold through ordinary retail outlets, generally in record stores and supermarkets. The most frequent customers for petitioner's

records are young people between the ages of 14 and 18.

Respondent Ford Motor Company is the second largest manufacturer in the automotive industry and one of the world's largest corporations. Its products include passenger cars, trucks, tractors, automotive parts and accessories, architectural and automotive glass, paint, vinyl products, missile and guidance systems, communications equipment and systems, electric components, computers and ball bearings. In addition, a Ford subsidiary acquired in 1961, Philco Corporation, manufactures home appliances under its own trademark.

Beginning in 1909, respondent has registered its trademark

for a variety of products including the following: explosive engines and parts, electrical apparatus such as spark plugs and magnetos, coal and charcoal briquets, lubricating oils, fertilizers, paints and auto polishes, and other articles and devices principally related to the automotive industry. Respondent has not, however, registered its trademark for phonograph records or tape recordings, or for recording or reproduction equipment. According to the testimony of its own archivist and historian, respondent has never been substantially known as a manufacturer of records or

tapes and is not now engaged in their manufacture or sale under its marks.

Beginning about 1948, respondent has made use of records, along with films and other materials, in training its personnel in the sale and servicing of Ford automobiles. Respondent's trademark first appeared on thse records in 1965, approximately seven years after petitioner's first use. Prior to that time the only trademarks appearing on the records belonged to the companies which actually manufactured the records, such as RCA Victor and Columbia, although the words "Ford Motor Company" or "Ford Division" do appear on some or all of them. According to respondent's witnesses, these records were and are simply tools to acquaint dealer sales and service personnel with respondent's automotive products. Typical titles including "Selling Ford vs. Plymouth"; "Closing the Deal"; and "The 1958 Ford Line".

Apparently beginning in 1963, respondent has also made its auto service training courses available at cost to trade schools, colleges and governmental agencies. Respondent's witness claimed that the records sold under this program were of more general interest than those sold exclusively for the training of respondent's personnel. Of the four exhibits offered, however, three bore the following

catchy titles: "Air Conditioning — Diagnosis, Adjustments and Repair"; "Rotunda R.E. 881 Analyser, Diagnosis and Testing"; "Vinyl Roof Repair and Replacement." The fourth was related to the automobile ignition system.

Records in both of respondent's programs are sold only in unit packages which include the record, booklets, a slide film and sometimes other material. The records themselves are 16" in diameter, much larger than petitioner's. They sell for $280 per unit for the first program and $22 a unit for the second. The $280, so-called first program record, moreover, is sold only to respondent's dealers and service personnel who solicit the materials directly from respondent. Although respondent has spent enormous sums of money in advertising its automobiles and, to some extent, its other products, no monies have been spent promoting the sale of records or tapes.

On June 30, 1964, petitioner filed for registration of his trademark, which had been in continuous use as a trademark on popular phonograph records and tape recordings manufactured by petitioner since November 1958 and had been used in interstate commerce since January 1959. Respondent opposed the application on the basis that it had many registrations for its trademark and that, although it

possesses no such registration for phonograph records, it has produced and sold records as a part of its training programs.

The Trademark Trial and Appeal Board, in a unanimous opinion dated June 12, 1969, found that sales of records by respondent were, until 1963, limited to sales to Ford dealers for use in training programs; that no sales of records were made to persons outside of respondent's organization until 1963; and that all records sold by respondent prior to 1965 bore the trademark of the recording companies that produced them and were identified with respondent only by the use of its trade name, for instance "Ford Division, Ford Motor Company", and by their subject matter, which was limited to technical and sales information regarding respondent's automotive products.

The Board concluded that there was no likelihood of confusion between the goods of petitioner and respondent and that petitioner was the prior user of the mark "Ford" in connection with sales of phonograph records. Accordingly, respondent's opposition was dismissed and its request for reconsideration was denied by the Board on August 2, 1969.

Respondent thereafter appealed to the United States Court of Customs and Patent Appeals. In a decision dated August 3, 1972, that court reversed the

decision of the Trademark Trial and Appeal Board on the sole ground that respondent's use of its trade name in connection with the production of records for sale to its dealerships was sufficient to cause the likelihood of confusion. Although recognizing that the content and method of distribution of petitioner's records differed widely from those of respondent's, the C.C.P.A. held that the likelihood of confusion exists because, it speculated, there was the possibility that petitioner would somehow attempt to produce records having the same content as respondent's and sell them to respondent's dealerships.

REASONS FOR GRANTING THE WRIT

I. A SERIOUS CONFLICT EXISTS BETWEEN THE TRADEMARK TRIAL AND APPEAL BOARD AND THE COURT OF CUSTOMS AND PATENT APPEAL WITH RESPECT TO THE CONSTRUCTION OF THE LANHAM ACT

This case poses a direct and substantial conflict between the Trademark Trial and Appeal Board and the Court of Customs and Patent Appeals as to the construction of §2(d) of the Lanham Act, 15 U.S.C. §1052(d), which requires registration of a trademark unless it "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . ." Cf. Brenner v. Manson, 383 U.S. 519, 522, 527 (1966). It is not disputed in this case, of course, that respondent has not registered its trade mark for phonograph records or recording tapes. The question presented here is whether petitioner's proposed mark so resembles a mark or trade name previously used by respondent with respect to such records or tapes that its use by petitioner is likely to cause confusion or mistake or to deceive.

The C.C.P.A. held, in effect, that the

statutory standard is met and that a registration may be defeated where:

1. The opposer has previously used a trade name containing the surname (that of the applicant) from which the proposed trademark is derived, on goods with an admittedly and distinctly different use and method of marketing and distribution; and

2. There is a bare theoretical possibility, absolutely unsupported in the record, that petitioner might somehow expand its business into the same line with respect to which respondent has previously used its trade name.*

The Trademark Trial and Appeal Board, on the other hand, held that the mere use of the opposer's trade name on such dissimilar goods does not create the likelihood of confusion, mistake or deception required by the statute and does not, therefore, preclude registration of the applicant's trademark.

This Court should, therefore, grant a writ of certiorari to the Court of Customs and Patent Appeals to resolve this dispute between the C.C.P.A.

* To analyze this specious contention, upon which the C.C.P.A. predicated its reversal of the Trademark Trial and Appeal Board, is to expose absurdity. Petitioner is not in the automobile business. How could he possibly produce and market a technical training record concerning automobile sales in competition with the nation's second largest automobile manufacturer?

and the Board as to the proper construction of §2(d) of the Lanham Act, 15 U.S.C. §1052(d). Brenner v. Manson, 383 U.S. 519, 522, 527 (1966) (certiorari granted to resolve "running dispute [between the C.C.P.A. and the Board] over what constitutes 'utility' in chemical process claims . . .").

II. RESPONDENT IS NOT THE PRIOR USER OF THE MARK "FORD"

It is too well settled to admit of dispute that one obtains no rights in a trademark unless he can show priority of use as a trademark on the goods. E.g., Bulova Watch Company, Inc. v. Waltham Watch Company, 408 F.2d 1062 (C.C.P.A. 1969); and Drexel Enterprises, Inc. v. Richardson, 312 F.2d 525 (10th Cir. 1962). It is also undisputed, of course, that respondent has not registered its trademark for use on phonograph records or tapes. The record is equally clear that respondent had not, at least until 1963, used its mark on any records. To the contrary, all records which respondent produced up to that time carried only its trade name, "Ford Motor Company", or such descriptive terms as "Ford Division". Respondent not only had not registered its trade name but it is clear that it could not possibly register such a trade name as a trademark. Ex parte Crest Food Co.,

112 U.S.P.Q. 190 (Comr. 1957); In re Lyndale Farm, 186 F.2d 723 (C.C.P.A. 1951); and Duncan Elect. Mfg. Co. v. Maryall, 95 U.S.P.Q. 242 (D. D.C. 1952). On each record produced by respondent, moreover, its trade name appears in conjunction with the trademark of the record company which actually manufactured the records—Columbia, RCA Victor or Universal. Petitioner's trademark, in contrast, has appeared on every record he has issued since entering the business in 1958, thus clearly establishing his prior use of the trademark in issue.

It is also clear that respondent, in placing the words "Ford Motor Company" on the training records which it produced, had no intention that these words serve as a trademark. Until 1963, distribution of respondent's training records was confined to its dealers and service personnel, with the few isolated exceptions of records which the dealers occasionally gave to schools and the like, and the few requests for the material which respondent received on a sporadic basis from persons outside its organization. The only persons who received these records and other training materials were those who solicited them directly from respondent.

The appearance of respondent's trade name on its training material, therefore, did not and was

not intended to create a reputation for the Ford Motor Company as a producer and distributor of records. Its purpose was not to induce any sector of the general public, or indeed even Ford dealers, to recognize and purchase the records. It was a mere stylistic authentication of the phonograph records, comparable to the use of a corporate name on inter-office memoranda, pencils, overalls, etc.

The only way the C.C.P.A. was able to overcome the manifest fact that the Ford Motor Company's use of its trade name on its training records was not and could not be a prior use of the mark petitioner seeks to register was to make the entirely unsubstantiated and irrelevant conclusion that the general public, in seeing the trade name Ford Motor Company on the records, would equate it simply with Ford. 462 F.2d at 1407. This was a curious, and fatally erroneous, conclusion inasmuch as the general public was not, of course, exposed to the Ford Motor Company training records.

In the first place, this conclusion overlooks the obvious fact, as found by the Trademark Trial and Appeal Board, that the average purchaser of records was not even aware in 1958, when petitioner began to use his mark on records, of respondent's recordings bearing its trade name. Moreover, by

concluding as it did, with no substantiation in the record, that the public would regard the trade name "Ford Motor Company" as equivalent to the trademark "Ford", the C.C.P.A. violated its own precedents and, indeed, all rules of good judicial practice.

Not only was there a complete absence of any facts in the record showing that the public would or did reach such a conclusion, but respondent did not even raise before the Trademark Trial and Appeal Board the issue of whether petitioner was not the prior user of the trademark "Ford" on records. Under such circumstances it was entirely improper for the C.C.P.A. to reach the unsupported conclusion that petitioner was not the prior user because the public equated its mark with respondent's trade name.

The C.C.P.A. has consistently held that it will not consider facts or issues which are not in the record or have not been reviewed by the Board. Rexall Drug Co. v. Manhattan Drug Co., 284 F.2d 391 (C.C.P.A. 1960); and Application of Retail Clerks International Protective Association, 149 F.2d 153 (C.C.P.A. 1945). Specifically, assertions that the public had reached or would reach certain conclusions with respect to trademarks or trade names will not be sustained unless there is a showing by a preponderance of evidence that the public does, in fact, reach such conclusions.

In In re W.A. Sheaffer Pen Co., 158 F.2d 390 (C.C.P.A. 1946), the appellant argued that the Commissioner of Patents had erred in denying registration of the mark "Fineline" for appellant's ball point pens on the grounds that the mark was "descriptive". Appellant argued before the C.C.P.A. that the term "Fineline" was not generally descriptive of ball point pens because it did not become associated with such pens in the minds of the public until the appellant had begun using it. The court, however, expressly rejected consideration of this contention, stating that there were no facts in the record upon which this conclusion could have been reached and, furthermore, the contention was not raised before the Commissioner. See also Bayuk Cigars, Inc. v. Schwartz, 1 F.Supp. 283 (D. N.J. 1932)(confusion of "Philadelphia" and "Phillies" on cigars).

Also apposite is Berghoff Brewing Association v. Popel-Giller Co., Inc., 273 F. 328 (App. D.C. 1921), where the appellant sought to register the mark "Bergo" on soft drinks, and appellee sought to register the mark "Burg", also on soft drinks. Appellant had first used its mark in 1917, whereas appellee had first used the mark "Burg" in 1918, although it had used "Burgmeister" for beer since 1916. The appellee maintained that it was the prior user because

the mark "Burgmeister" was frequently interpreted and referred to by the public as "Burg". The court expressly rejected appellee's contention that this constituted proof of prior use (273 F. at 329):

> "We are not impressed by this contention. The mere use of "Burg," as an abbreviation for the word "Burgmeister," in conversation, or in written orders for goods, is not sufficient to establish a trade-mark use.
>
> * * * * *
>
> "There is no proof that appellee ever attached the word to goods of the kind for which it is sought to register it as a trade-mark prior to 1918. Its adoption, if adopted at all, was by its customers, not as a mark to designate the goods, but as a name to designate goods bearing the mark "Burgmeister." This did not, therefore, constitute a trade-mark use. Coca-Cola Co. v. Branham (D.C.) 216 Fed. 264."

Finally, not only does the record not support the conclusion that the public would interpret "Ford Motor Company" to mean the same as "Ford", but the record, in fact, compels the contrary conclusion. The only persons who would have come in contact with respondent's recordings prior to the time when petitioner began producing and selling records to the public were members of respondent's own organization or its authorized dealers. These purchasers of respondent's records were hardly casual purchasers; the restricted distribution of the records, their high price and highly specialized purpose assured that. As sophisticated purchasers buying or using the

training records of Ford Motor Company for a highly specialized purpose, they obviously knew full well the source of such records and would not carelessly equate the trade name "Ford Motor Company" with petitioner's distinctive mark "Ford Records" on his entertainment records.*

Therefore, the conclusion of the C.C.P.A., contrary to that of the Trademark Trial and Appeal Board, that petitioner was not the prior use of the trademark "Ford" on records is clearly a misapplication and misconstruction of the governing statute, and this Court should grant review in order to correct this egregious error and definitively determine the true construction of 15 U.S.C. §1052(d).

* The same conclusion obtains if, to indulge for a moment the speculation of the C.C.P.A., petitioner, contrary to the evidence in the record, were for some strange reason to attempt entry into the automotive sales training field.

III. THERE IS NO LIKELIHOOD OF CONFUSION

A. Petitioner's Goods Are Entirely Different from Those of Respondent

Assuming, arguendo, that respondent is the prior user of the trademark Ford on goods which may be generically described as phonographic records, those goods are, nevertheless, so utterly dissimilar to the goods produced by petitioner that there is no likelihood of confusion. Moreover, petitioner's distinctive trademark "Ford Records" is not the trade name "Ford Motor Company", nor can it, in any manner, be equated with such trade name.

Where one looks for likelihood of confusion, under circumstances where the marks are quite similar, one looks to the market place. Considerations include the nature of the goods, how they are sold, to whom, with what purpose and under what circumstances. (Seidel, Dubroff & Gonda, Trademark Law & Practice, §16.08 (1963)). Even though the marks are identical, if the goods are dissimilar there may be no confusion. Swissair: Swiss Air Transport Co. Ltd. v. B.W. Harris Mfg. Co., 125 U.S.P.Q. 25 (T.T.A.B., 1960) (airline and clothing); Fred W. Amend Co. v. American Character Doll Co., 223 F.2d 277 (dolls and candy).

In Ex parte B. Fisher & Co., Inc., 110

U.S.P.Q. 309 (Comr. 1956), opposer and applicant both sold animal feed but were allowed registrations of similar trademarks, the one for dog and cat food, the other for livestock feed, because these products were not sold:

(a) in the same channels of trade;

(b) through the same retail outlets;

(c) to the same type of purchaser;

(d) under similar circumstances or conditions; and

(e) they were not considered in any sense competitive products.

If the court finds significant differences between the products in any one of the above categories it may allow registration. See, e.g., Pep Boys, Manny, Moe and Jack v. Edwin F. Guth Co., 197 F.2d 527 (C.C.P.A. 1952); Alligator Co. v. Larus & Bro. Co., Inc., 196 F.2d 532, 537 (C.C.P.A. 1952); Ex parte Helene Curtiss Industries, Inc., 112 U.S.P.Q. 271 (Comr. 1957); Sales Affiliates, Inc. v. Mayer, 115 U.S.P.Q. 8 (Comr. 1957); Brown & Bigelow v. Muench-Kreuer Candle Co., Inc., 114 U.S.P.Q. 348 (Comr. 1957); Ex parte Jewel Foliage Co., 100 U.S.P.Q. 63 (Comr. 1953); American Safety Razor Corp. v. W.G. Shelton Co., Inc., 70 U.S.P.Q. 243 (Comr. 1946); and McKesson & Robbins v. Abbott Laboratories, 59 U.S.P.Q.

233 (Comr. 1943).

The rationale for the considerations embodied in the above decisions stems from the fact that the trademark law "was originally designed to protect the mark's owner from the diversion of customers who would otherwise have bought of him." S.C. Johnson and Son v. Johnson, 175 F.2d 176, 178 (2d Cir. 1949) (Learned Hand, J.).

> "The first use of a trade-mark of a specific common name does not, by and of itself, give the first user the right to prevent a subsequent 'fair use' of the identical name by others on different articles. Richfield Oil Corp. v. Dieterich Field, Inc. (C.C.P.A. 1960) 279 F.2d 885, 886." General Motors Corp. v. Cadillac Marine & Boat Co., 226 F.Supp. 716, 730 (W.D. Mich 1964).

As Judge Hand later stated:

> "In all such cases there is only one question: what damage to the first user will the second do by the use of the first user's mark, or name or make-up, and what burden will it impose upon the second user effectively to distinguish the goods?" Federal Telephone & Radio Corp. v. Federal Television Corp., 180 F.2d 250, 251 (2d Cir. 1950), approved in General Motors, supra at 730.

If the goods are not similar there will be no competition between them and, hence, no chance of damage to respondent's sales as a result of petitioner's use.

The improbability of any confusion is heightened by the fact that the only purchasers of respondent's recordings are automobile dealers or repairmen or institutions who train students in

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automobile mechanics. Such persons are obviously highly sophisticated and discriminating purchasers who buy the recordings for a specific, well defined purpose and are unlikely to be mislead by any similarities between the two marks. It is well settled that oppositions to trademark applications will be dismissed where the goods in question are purchased only by such discriminating buyers, especially when the goods are used principally for industrial purposes. Synchromatic Air Conditioning Corp. v. Williams Oil-O-Matic Heating Corp., 109 F.2d 784 (C.C.P.A. 1940)(air conditioners); Magnaflux Corp. v. Sonoflux Corp., 231 F.2d 669 (C.C.P.A. 1956)(products used to test imperfections and flaws in metals). See also Lauritzen & Co., Inc. v. Borden Co., 239 F.2d 405 (C.C.P.A. 1956); Clark Equipment Co. v. Baker-Lull Corp., 288 F.2d 926 (C.C.P.A. 1961); National Motor Bearing Co., Inc. v. James-Pond-Clark, 266 F.2d 799 (C.C.P.A. 1959); and Pep Boys—Manny, Moe and Jack v. Edwin F. Guth Co., 197 F.2d 527 (C.C.P.A. 1952). This rule has been applied even where the marks were virtually identical and the goods were of the same descriptive character. Kramer Trenton Co. v. Walcutt, 408 F.2d 479 (C.C.P.A. 1969)("Winterizer" and "Winterstate" on refrigerator systems).

The discriminating purchasing test has also been applied to goods sold to the general public. Lever Bros. Co. v. Geo. A. Hormel & Co., 173 F.2d 903 (C.C.P.A. 1949)(shortening); Sleepmaster Products Co. v. American Auto-Felt Corp., 241 F.2d 738 (C.C.P.A. 1957)("Restmaster" and "Rest Master" on mattresses).

On the basis of these authorities, it seems clear that there can be no real likelihood of confusion. It is obvious that those Ford dealers and educational institutions interested in learning about the Ford line and automobile repairs would be especially careful to purchase records coming directly from Ford and would not be mislead into buying petitioner's musical recordings. Equally obvious is the fact that purchasers of petitioner's records will not be mislead or "confused" to believe that they emanate from the automobile company.

B. There Is No Likelihood That Petitioner Will Produce the Same Type of Goods as Respondent

Although the records produced by petitioner are concededly entirely different both in content and method of distribution from those training records produced by respondent, the C.C.P.A. nevertheless reversed the Board decision dismissing respondent's opposition, stating (462 F.2d at 1407):

> "Registration of FORD RECORDS in this case would give appellee the §7(b), 15 USC 1057(b), benefits of registration for records and tapes of all description. There is no guarantee that appellee would always refrain from producing records having the same content as appellant's and selling or offering them to the appellant's dealerships. Feed Service Corp. v. FS Services, Inc., 58 CCPA 708, 710, 432 F.2d 478, 480, 167 USPQ 407, 408 (1970). Viewed in this light, the present opposition is based on an allegation of likelihood of confusion arising from the contemporaneous use of the same mark on the same goods sold through the same channels of trade. Given the strength of the FORD mark as an indication of Ford Motor Company as the source of goods bearing the mark, we have no difficulty concluding that there would be a likelihood of confusion, mistake or deception."

This holding completely misconstrues the requirements of §2(d) of the Lanham Act, 15 U.S.C. §1052(d), and is patently erroneous in every material respect.

The test under Section 2(d) and the only permissible grounds for defeating a registration is the likelihood of confusion. E.g., Clifton v. Plough, Inc., 341 F.2d 934 (C.C.P.A. 1965). The statute does not permit a registration to be thwarted on the basis of a mere theoretical possibility of confusion. Coty, Inc. v. Joseph Dixon Crucible Co., 102 F.2d 209 (C.C.P.A. 1939); Norton Co. v. Bear Mfg. Co., 438 F.2d 620 (C.C.P.A. 1971); Universal Sewing Machine Co. v. Standard Sewing Equipment Corp., 185 F.Supp. 257 (S.D.N.Y. 1960). Cf. Application of Myers, 201 F.2d 379 (C.C.P.A. 1953). As the court stated in Coty,

supra, 102 F.2d at 211, "Trade-mark laws as a whole, and the registration law here involved in particular, were never designed to afford a remedy for every remote and far-fetched claim of damage." The statute does not require the registrant to give a "guarantee" to potential or actual opposers, as stated by the C.C.P.A.

Furthermore, the theoretical possibility of petitioner's expanding his product line into a new field and producing training records of the type produced by respondent is not even a proper consideration in opposition proceedings of the sort involved here, as has been recognized both by the C.C.P.A. itself, Ward Baking Co. v. New Standard Baking Co., 71 F.2d 186 (C.C.P.A. 1934), and by the Patent Office and the Board. See, e.g., McKesson & Robbins, Inc. v. A.G. Spaulding & Bros., Inc., 76 U.S.P.Q. 485 (Comr. 1948); and Singer Mfg. Co. v. Singer Glove Mfg. Co., 126 U.S.P.Q. 291 (T.T.A.B. 1960). Finally, though the C.C.P.A. asserts, but does not and cannot document, that the opposition is based on the "same mark" on the "same goods" through the "same channels of trade" the opposite is true in each of these three respects.

The case upon which the C.C.P.A. relied, Feed Service Corp. v. FS Services, Inc., 432 F.2d

478 (C.C.P.A. 1970), is inapposite. In that case both the opposer and the applicant produced animal feed which was sold to the same class of purchasers. The applicant contended that because its goods were sold primarily by door-to-door salesmen while the opposer's were sold "off the shelf", there would be no likelihood of confusion. The court rejected that contention, stating that it was always possible for the applicant to change its marketing methods. It seems obvious that the factual situation in Feed Service was greatly different from that presented here, since in that case the market for the goods of both parties was precisely the same and it would be very easy for the applicant to make a change in its methods of distribution. Here, on the other hand, the markets involved are entirely different—the general musical record buying public versus the highly specialized purchasers of automotive training records. Furthermore, the fact that petitioner has to charge very large prices for its training records in order merely to break even makes it entirely implausible to suggest that petitioner, who produces records for a profit, would be likely to enter the same field.

The C.C.P.A. has therefore misapplied §2(d) of the Lanham Act, inasmuch as the record suggests

only the barest possibility that petitioner might produce the same kind of records as respondent, and this possibility is not sufficient to defeat petitioner's registration.

CONCLUSION

For the foregoing reasons, a writ of certiorari should issue to review the judgment and opinion of the United States Court of Customs and Patent Appeals.

Dated: November 1, 1972

Respectfully submitted,

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APPENDIX A

Hearing:
April 1, 1969

AE
Paper No. 41

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Trademark Trial and Appeal Board

Ford Motor Company
v.
Sherman Ford, Jr.

Opposition, No. 46,028, to application Serial No. 196,776, filed June 30, 1964.

Glenn S. Arendsen and John R. Spielman for Ford Motor Company.

Caesar L. Pitassy, Eugene T. Rossides and John M. O'Hare for Sherman Ford, Jr.

Before Leach, Lefkowitz, and Shryock, Members.

Opinion by Lefkowitz, Member:

An application has been filed by Sherman Ford, Jr., doing business as Ford Records, to register the following as a trademark for phonograph records and recording tapes, use of the mark since November 13, 1958 being alleged.

The word "RECORDS" and the representation of the phonograph record have been disclaimed apart from the mark as shown.

Registration has been opposed by the Ford Motor
mpany, which alleges that opposer, since long prior to
vember 13, 1958, has continuously used the trademark
RD" and its trade name "FORD MOTOR COMPANY" in connec-
n with the manufacture and marketing of its many
oducts, including automobiles, radios, record players,
e players, motion picture films, phonograph records, and
corded tapes; that opposer is the owner of a number of
gistrations of "FORD" covering a variety of products such
explosive engines and their parts;[1] electrical equipment;[2]
l and charcoal briquettes;[3] lubricating oils;[4]
tilizer;[5] plate glass and lenses for automobiles;[6]
edometers, ammeters, and motion picture films;[7] spark
g;[8] paint, varnishes, and automobile polishes;[9] and
io receiving sets and parts thereof;[10] that opposer's
demark "FORD" and the trade name "FORD MOTOR COMPANY" are

[1] Reg. No. 74,765, issued Aug. 10, 1909 and twice renewed.
[2] Reg. No. 115,500, issued Feb. 20, 1917 and twice renewed.
[3] Reg. No. 222,321, issued Dec. 28, 1926 and twice renewed.
[4] Reg. No. 232,051, issued Aug. 30, 1927 and twice renewed.
[5] Reg. No. 249,344, issued Nov. 13, 1928 and twice renewed.
[6] Reg. No. 250,072, issued Nov. 27, 1928 and twice renewed.
[7] Reg. No. 250,230, issued Dec. 4, 1928 and twice renewed.
[8] Reg. No. 257,500, issued June 11, 1929 and renewed.
[9] Reg. No. 266,822, issued Feb. 4, 1930 and renewed.
[10] Reg. No. 361,140, issued Oct. 11, 1938 and renewed.

known throughout the United States and the world as identifying automobiles and other vehicles produced by opposer along with electrical and electronic equipment therein; that, in addition, opposer and its subsidiaries are using the "FORD" trademark and the trade name "FORD MOTOR COMPANY" on an increasing number of sound recording and sound reproducing equipment; that opposer and its subsidiaries have spent large amounts of money in advertising the "FORD" mark and the trade name "FORD MOTOR COMPANY" for a wide variety of products and in building up and maintaining a valuable business in these products; and that in view of this extensive use and advertising of "FORD" and "FORD MOTOR COMPANY" by opposer and its subsidiaries, whose use inures to the benefit of opposer, "the public will be confused if another registers and uses a mark or design including a dominant display of the word "FORD" on phonograph records and recording tapes, resulting in damage to the Opposer".

The record consists of the pleadings, applicant's application, copies of opposer's pleaded registrations, testimony in behalf of each party, and a brochure noticed by opposer under Rule 2.123(c).

Opposer is one of the largest industrial organizations in the world. It is one of the largest manufacturers of automobiles, trucks, tractors and engines, parts, and accessories

therefor, and produces as well glass, paint, steel, vinyl products, fertilizers, and a large number of other diverse products. Opposer's principal emphasis, however, has been in the automotive vehicle field. Most of the products manufactured by opposer have, for a considerable period prior to 1958, been marketed in association with its "FORD" trademark and its trade name "FORD MOTOR COMPANY". Radios have been a common accessory of opposer's automobiles for many years and, while opposer's witness was not certain as to whether or not the mark "FORD" or the trade name "FORD MOTOR COMPANY" appears thereon, since opposer is the owner of a subsisting registration of "FORD" for radios, we will assume for purposes herein that the term "FORD" has been used by opposer as a trademark to identify and distinguish the radios incorporated in its vehicles. In the fall of 1964, with the advent of the 1965 "FORD" vehicles, opposer introduced a tape player or recorder as another item of entertainment equipment for motor vehicles. This equipment, however, and the tapes therefor bear the name of the manufacturer, a company or companies other than opposer. As evidenced by the printed publication opposer introduced into evidence under Rule 2.123(c), one of opposer's competitors introduced a phonograph record player as a factory installed accessory in 1959. This unit interestingly enough, as depicted in the printed matter, bears the mark "RCA VICTOR".

Opposer's sales of products bearing the "FORD" trademark and/or the trade name have been very substantial. Large amounts of money have been invested by opposer in placing the trademark "FORD" and the trade name "FORD MOTOR COMPANY" before the public through network television, magazines, newspapers, radio, outdoor postings, direct mail as well as dealer distributed literature, trade publications, and the like. Selecting the years 1953, 1956, 1959 and 1963 as illustrative, opposer expended in excess of twenty million dollars, forty-six million dollars, fifty seven million dollars, and seventy million dollars, respectively, in advertising products bearing the "FORD" trademark or "FORD MOTOR COMPANY". The total amount spent in advertising such products was in excess of one hundred and ninety-five million dollars for the years 1953 through 1957, and in excess of eight hundred and forty million dollars for the years 1953 through 1967.

There is testimony that opposer, at one time, published and distributed to the general public sheet music bearing the notation "Published by the Ford Motor Company". The witness could remember but one title, namely, the "Ford March and Two-Step", and there is nothing in the record to indicate that opposer is or has, for the past few years, been engaged in any similar activity. Opposer, for a considerable period of time, produced motion picture films for

both educational and corporate purposes. In this regard, opposer maintained an educational film library containing films on a variety of subjects including geography, history, and manufacturing. Some titles of the films were "Salmon Fishing in the Northwest", "The Story of a Bar of Soap", "Olive Growing", and the like, many of them totally removed from the automobile business as such. The newsreel and documentary type films were distributed through motion picture houses whereas the educational films were sold directly to educational institutions, schools, and the like, along with teacher manuals for their use. The word "FORD" or "THE FORD MOTOR COMPANY" appeared at both the beginning and end of each film. As in the case of the sheet music, the testimony is silent as to whether or not opposer is presently engaged in producing educational films of this type. But, unlike the sheet music, since opposer possesses a subsisting registration of "FORD" for motion picture film, we will assume that this activity is still going on. However, in the absence of evidence in this regard, we will not assume that it is an extensive operation or that it is regularly advertised to the general public or educational institutions, or that such persons are, in fact, aware of opposer's activities in preparing and distributing educational films.

Since about 1948, opposer has produced and sold training materials such as records, slide films, manuals, handbooks, brochures, and similar descriptive material to "FORD" dealers for use in training personnel in the sale and servicing of "FORD" vehicles. Most of this material has been sold as a package in each model year. The records and film strips have been generally sold together since the film strips are a visual presentation of material contained in the records and go hand-in-hand with each other. The trademarks of such well-known record manufacturers as "RCA VICTOR" and "COLUMBIA" appear on the records along with such titles as "Ford Division, Ford Motor Company Presents the 1958 Ford Line", "Ford Division Presents New Worlds to Conquer", "Ford Motor Company Presents Ford Mechanic Service Forum", "Ford Motor Company Presents Selling Ford Versus Plymouth", "Ford Motor Company Presents My Business Is Different", subtitled "Used Truck Merchandising Volume 48", and the like. This material or training program is confined generally to "FORD" dealers and service personnel who solicit the materials directly from opposer. There is testimony that the records are occasionally given away by dealers to schools and the like and that opposer has received requests for this material from persons and organizations outside of its organization but this apparently has been on an occasional or "every once in a while" basis. Only orders from opposer's dealers

were offered in evidence. Opposer has sold about seven hundred and twenty thousand of such records in commerce in the period from 1950 to 1958, and it was estimated that between three thousand and thirty-three hundred out of opposer's approximately six thousand dealers purchase the training materials.

In addition, beginning in 1963, opposer made its auto service training material available at cost to trade schools, colleges and governmental agencies, owners of fleets of vehicles, and independent service garages. This material, like the program directed to "FORD" dealers, is sold in a package including full color slide films with a record, a training handbook, overheard projection slides in color, instructor's notes, and sometimes other materials. Nine to fifteen subjects a year are covered by this material. The records bear the logo "Ford Motor Company, Service Training, Ford Division" plus the subject matter or title of the record as "Fundamentals of Electricity, Course 13T", "Air Conditioning Diagnosis, Adjustment and Light Repair, Course 19T1" and "Rotunda, RE881 Analyzer, Diagnosis and Testing Course, 12T11". Orders for this material again are placed directly with opposer. This program has been advertised in "School Shop", "American Vocational Journal", and "VICA" (Vocational Industrial Clubs of America), and catalogues of available material have been distributed to interested persons. Approximately eight hundred to one thousand of these records have been sold by opposer in each

of the years 1963 to 1967. Opposer does not, however, itself manufacture the records involved, and it is admitted that opposer has not been substantially known as a manufacturer of records or tape recordings.

In 1961, opposer acquired, as a subsidiary, the Philco Corporation, a manufacturer of radios, phonographs, television receivers, air conditioners, and other home appliances. The fact that Philco Corporation was a subsidiary of Ford Motor Company was indicated on the products subsequently produced and/or the literature pertaining thereto. In or about 1965, the mark appearing on these goods was changed from "PHILCO" to "PHILCO/FORD". Philco Corporation began to manufacture miniature "Hip Pocket" records for a special record player in 1967. It does not, however, make or sell recording tapes.

Applicant has been in the commercial popular recording industry since 1957. He has, since the middle of 1958, been engaged in the manufacture and sale of popular phonograph records under the trade name "Ford Records" and identified by the mark shown above featuring his surname "FORD". During the ten year history of his company, applicant has produced approximately fifty 45 R.P.M., seven inch records and thirty 33 1/3 R.P.M., twelve inch long-playing records of which thirty 45's and six albums were released and offered for sale. Applicant's records have been of instrumental and vocal music, including rock and roll and

standard popular music as well as folk, country and western music and opera. The mark in question appears on the record labels and on the covers or jackets therefor. Applicant has consistently leased and attempted to lease primarily abroad master tape recordings, and he has tape cartridges now in production. When the master recording tapes are leased, records made therefrom bear a legend such as "A Ford Recording from U.S.A." or "A Ford Recording".

Applicant's records are marketed through distributors who send or take the new releases to radio or television studios in the hope that they will be played by the disc jockeys. Applicant personnally aids in these distribution efforts by direct contact with distributors, disc jockeys, and other promotional people. Applicant has advertised on a continuous basis since 1958 in the major trade journals of the radio and recording industry such as "Billboard", "Cash-Box", and "Variety". In addition, applicant's records bearing his "FORD" mark have been reviewed and otherwise publicized in these and other publications.

Applicant's records, at the retail level, are sold generally in record stores and similar outlets at the standard retail prices of $.98 for 45 R.P.M. records and $3.98 for an album. The most frequent customers buying applicant's records are teenagers between the ages of fourteen and eighteen. Applicant's gross volume of busi ess

has been estimated at nine thousand dollars, a minuscule amount for a nine year period, and it is admitted that applicant did not make any commercial sale of records until 1960. However, applicant has offered for sale or actively attempted to sell "FORD" phonograph records and tape recordings as a business venture with a profit motif in every year since he started in business in 1958. It appears that the recording business is something like the oil exploration business in that you make many explorations or recordings with the hope that one day you will strike it rich with a record that sells a million copies. Apart from all this, applicant's record supports the conclusion that he has made a public use of the mark "FORD" in connection with phonograph records since the middle of 1958, a time long before opposer acquired the Philco Corporation, long before opposer made its training records and materials available on a regular basis to the general public or institutions, and long before record or tape players w introduced as a built-in accessory in automobiles. We are not, moreover, persuaded that the average purchaser of records, as distinguished from "FORD" dealers and their personnel, was aware in 1958 of opposer's sales and service training materials which included records used in conjunction with slide films. Insofar as "FORD" dealers and employees are concerned, it is apparent that they would be familiar with opposer's activities under the mark "FORD" and would not suppose that "FORD" modern musical records

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originate with or are, in some way associated with opposer.

It is our opinion, on the record before us, that opposer's claim of damage herein must be predicated on its extensive use of "FORD" in the automotive field. In this regard, there can be no question but that "FORD" both as a trademark and as the salient feature of the trade name "FORD MOTOR COMPANY" has become, over the years, an extremely well-known or celebrated mark in the automobile industry indicating automotive vehicles, and parts and accessories specifically designed for such vehicles originating exclusively with opposer; that opposer, by reason thereof, possesses rights in "FORD" sufficient to preclude the subsequent registration thereof for all products which purchasers might naturally assume to emanate from opposer in the normal expansion of its business. /See: J. C. Hall Company v. Hallmark Cards, Incorporated, 144 USPQ 435 (CCPA, 1965) and cases cited therein/; and that while the word "FORD" is applicant's surname, it is well established that when one elects to use a family surname as a trademark or as a part of trademark, the name, for that purpose, is severed from the owners personality and registrability thereof is subject to the same consideration as other types of marks including the prohibition of Section 2(d) against the registration of marks where confusion, mistake or deception is likely to occur. /See: Lyon Metal Products, Incorporated v. Lyon Incorporated, 134 USPQ 31 (TT&A Bd., 1962); The J. B. Williams Co. v. Ernest W. Williams, 8 USPQ 539 (CCPA, 1931); and

Schonley Industries, Inc. v. Battistoni, 112 USPQ 485 (Comr., 1957). However, as set forth in Richfield Oil Corporation v. Dieterich Field, Inc., 126 USPQ 359 (CCPA, 1960) at p. 360:

> "First use as a trademark of a specific name such as 'RICHFIELD' does not, by and of itself, give the first user the right to prevent subsequent fair use of the same name by others on different articles".

citing Federal Telephone & Radio Corporation v. Federal Television Corporation, 84 USPQ 394 (CA 2, 1950) wherein the court said at p. 395 that:

> "Although there appears to be a persistent belief that the first use of a specific name or description gives a power to the first user to prevent its use by others, it is important to remember that no such doctrine exists. In all such cases there is only one question, what damage to the first user will the second do by the use of the first user's mark, or name or make-up, and what burden will it impose upon the second user effectively to distinguish the goods?"

See also-S. C. Johnson & Son, Inc. v. Johnson et al., 121 USPQ 63 (CA 6, 1959) wherein it was stated at p. 70 that:

> "The law, however, recognizes and supports the right of every individual to his own surname in his own trade or business so long as it does not work either an actual or constructive fraud upon the complaining party or the general public'. . . ."

While it is always possible when two merchants use the same name that some confusion may arise, and that the reputation of one, whether good or bad, may therefore be transferred, there is no substantial basis on the record before us to conclude that either the interests of opposer or of the general public will be endangered by applicant's registration of its "FORD" mark for phonograph records and recording tapes. That is, considering that applicant's phonographic records and tapes and opposer's automotive vehicles and equipment designed therefor are fundamentally different in every material aspect; they are distributed through different and wholly unrelated channels of trade; and they are purchased under different conditions and circumstances, i.e., in a milieu in which a purchaser of a record is not likely to associate with the retail outlets of opposer; and considering that "FORD" is an exceedingly common surname, it is not believed that purchasers would be likely to attribute such distinctly different goods to a single source merely because of the common surname "FORD".

Decision:

The opposition is dismissed.

M. Leach

S. Lefkowitz

R. F. Shryock

Members, Tradomark
Trial and Appeal Board

APPENDIX B

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

ORD MOTOR COMPANY,	October Term	1971.
Appellant,		
v.	Patent Appeal No.	8704.
HERMAN FORD, JR., d/b/a FORD RECORDS,		
Appellee.	Opposition No.	46,028.

August 3, 1972

ARE, Judge.

This appeal is from the decision of the Trademark Trial and Appeal Board, reported in full at 162 USPQ 418 (1969), dismissing Ford Motor Company's opposition to the registration of FORD RECORDS, [1] stylized as shown in the board's published opinion, [2] for "phonograph records and recording tapes." We reverse.

---

[1] Application Serial No. 196,776 filed June 30, 1964, with an alleged date of first use in interstate commerce of January 20, 1959.

[2] 162 USPQ at 418.

The record shows that since late in 1958 appellee has been using the mark FORD RECORDS in connection with the production of records in the musical entertainment field. Prior thereto, appellant produced records for sale to its dealerships, the content being directed to matters of interest to a Ford dealer, e.g., methods of selling Ford automobiles and mechanic training information. The labels on those records bore the Ford Motor Company trade name, and, in some cases, the Ford Division trade name, as well as the name of the record manufacturer, such as RCA VICTOR and COLUMBIA. Appellant has since expanded to the production of educational records and films. Although it has no prior trademark registration on records, appellant has many registrations of the FORD trademark in connection with a wide diversity of goods. It is uncontested that appellant is one of this country's largest corporations and that the FORD mark and FORD MOTOR COMPANY trade name in connection with its many products are well known.

Appellant alleged that appellee's use of FORD on records would be likely to cause confusion, mistake or deception as to the source of the goods. Section 2(d) of the Lanham Act, 15 USC 1052(d). It relies on certain of its prior registrations, such

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as one for "radio receiving sets and parts," as well as the general use of its trademark FORD and trade name FORD MOTOR COMPANY. We focus on its specific use of the company trade name in connection with the production of records for sale to its dealerships described above since we find that use sufficient to compel reversal of the board's decision.

The board concluded that there would be no likelihood of confusion primarily because it perceived a difference in the goods to which the parties apply the name FORD, i.e., phonograph records versus automotive products, and the attendant differences in the channels of trade and distribution of those goods. The board's premise was that "opposer's claim of damage * * * must be predicated on its extensive use of 'FORD' in the automotive field." This conclusion was reached despite a finding by the board that "Opposer has sold about seven hundred and twenty thousand of such records in commerce in the period from 1950 to 1958, and it was estimated that between three thousand and thirty-three hundred out of opposer's approximately six thousand dealers purchase the training materials." Those figures indicate substantial record production on appellant's part, and appellant's sales far exceeded appellee's. We think

the board was in error in failing to base the likelihood of confusion inquiry on appellant's activity in record production.

Appellee takes the position that its use of FORD in connection with records was prior to that of appellant's since appellant used only the FORD MOTOR COMPANY trade name on its records prior to appellee's use of FORD. Appellee confuses several propositions in the course of its argument. It urges that use of a trade name is not a trademark use sufficient for establishing rights to a mark. However, appellant is not here trying to register FORD for records and need not establish trademark use sufficient for registration. Section 2(d) provides in pertinent part:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --
>
> * * *
>
> (d) consists of or comprises a * * * trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive * * *.

Appellant can, and does, oppose on the basis of this statutory provision. The use of the FORD MOTOR COMPANY trade name is so

PA 8704

intimately related to the FORD trademark that the average purchaser would react, in our view, to the trade name as though it were simply FORD. We conclude that appellee's characterization of itself as the prior user of FORD as applied to records is erroneous.

Appellee's records and tapes are musical in content. Their mode of distribution is through channels normal in the musical entertainment trade. Appellant's records are different in content and mode of distribution. These admitted differences could reasonably give rise to a conclusion of no likelihood of confusion even where the marks are identical. However, these differences are not relevant to this appeal for the reason that appellee's description of the goods in his application for trademark registration fails to limit either the content or the method of distribution and sale of the records and tapes. Registration of FORD RECORDS in this case would give appellee the § 7(b), 15 USC 1057(b), benefits of registration for records and tapes of all description. There is no guarantee that appellee would always refrain from producing records having the same content as appellant's and selling or offering them to the appellant's dealerships. Feed Service Corp. v. FS Services, Inc., 58 CCPA 708, 710, 432 F.2d 478, 480, 167 USPQ 407, 408 (197

Viewed in this light, the present opposition is based on an allegation of likelihood of confusion arising from the contemporaneous use of the same mark on the same goods sold through the same channels of trade. Given the strength of the FORD mark as an indication of Ford Motor Company as the source of goods bearing the mark, we have no difficulty concluding that there would be a likelihood of confusion, mistake or deception.

As correctly observed by the board, the interest in allowing an entrepeneur to use his own surname as a trademark on his goods must give way to the more compelling public and private interests involved in avoiding a likelihood of confusion or mistake as to source where use of the surname leads to such confusion or mistake. That is the case here, and this opposition should have been sustained. The board's decision dismissing the opposition is accordingly reversed.

REVERSED

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Supreme Court, U. S.
FILED
DEC 1 1972
MICHAEL RODAK, JR., CLERK

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1972

No. 72-678

SHERMAN FORD, JR., d/b/a
Ford Records,

Petitioner,

-against-

FORD MOTOR COMPANY,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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15 U.S.C. §1067 6

Other Authorities

Stern & Gressman, Supreme Court Practice, §4.11, p.267 (Bur. Natl. Affairs, 1969) 7

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1972

No. 72-678

SHERMAN FORD, JR., d/b/a
Ford Records,

Petitioner,

-against-

FORD MOTOR COMPANY,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Respondent, Ford Motor Company, respectfully submits this brief in opposition to

the petition of Sherman Ford, Jr., seeking a writ of certiorari.

Statement of the Question Presented

Petitioner's statement of the question presented is misleading and inaccurate. A better statement of the question to this Court would be:

> Was the CCPA correct in applying the statute to the facts of the case and denying registration to petitioner on the grounds that respondent's prior trade name use of the same designation (FORD) on the same goods (phonograph records) was likely to cause confusion?

Statement of the Case

The petitioner's statement of the case incorrectly characterizes the decision below which, as printed in full in the petition as Appendix B speaks for itself. The statement of the case also dwells on insignificant and irrelevant facts, and a better statement

of the factual background involved can be obtained from the factual review of the decisions of the tribunals below which are reproduced in the petition as Appendices A and B, especially Appendix B.

Reasons for Denying the Writ

Petitioner seeks review on writ of certiorari of a judgment of the Court of Customs and Patent Appeals but has not indicated any "special and important reasons therefor"[1/] and in point of fact there are none. For this reason alone the petition should be denied.

The decision for which review is sought was a routine judgment in which the Court of Customs and Patent Appeals (CCPA) reversed

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1/ Rule 19 RULES OF THE SUPREME COURT

a decision of the Trademark Trial and Appeal Board (TTAB), an administrative board within the Patent Office, over which the CCPA has statutory appellate jurisdiction.[2/]

The petitioner does not rely on any of the reasons specified in Rule 19(1)(b), of this Court but requests this Court to resolve a "dispute" between the CCPA and the TTAB.[3/] This "dispute" arises from the simple fact that the CCPA reversed the TTAB, over which it has appellate jurisdiction on the record. This is simply a case of an appellate court reversing a lower court or administrative

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2/ 15 U. S. C. §1071

3/ The general considerations of Rule 19(1) are applicable to certiorari petitions to review CCPA cases. Rule 19(2) RULES OF THE SUPREME COURT.

agency over which it has appellate jurisdiction. This is no more of a dispute than any other reversal of the TTAB by the CCPA, and nothing has been presented to show that it was anything more than routine. The CCPA decision turned solely on an analysis of the facts involved. This Court does not and should not grant certiorari to "review evidence and discuss specific facts". U. S. v. Johnston 268 U. S. 220, 227 (1925).

As authority for granting the writ petitioner places mistaken reliance upon Brenner v. Manson 383 U. S. 519, 522, 527 (1966) wherein certiorari was granted "... to resolve this running dispute over what constitutes 'utility' in chemical process claims, as well as to answer the question concerning our certiorari jurisdiction" 383

U. S. at 522. However, as this Court's footnote at that point notes "In addition to the clear conflict between the Patent Office and the CCPA, there arguably exists one between the CCPA and the Court of Appeals for the District of Columbia" (citations omitted). Thus, Brenner v. Manson presented "two questions of importance to the administration of the patent laws." (emphasis added) 383 U. S. at 520, as well as a conflict between two courts of appeal. This case involves no important issues or questions as concerns administration of the trademark registration law, and no conflict between appellate courts. 4/ Importance of the issues

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4/ The TTAB is not even a court much less a court of appeals, 15 U.S.C. §1067. The function of the TTAB in the proceedings below was to make an administrative determination of trademark registrability after an interparties proceeding under the statute. The TTAB did not even exercise its appellate function in the proceedings below.

involved is of major significance in determining whether the writ of certiorari will issue. 5 /

This case involves simply the right of petitioner to register FORD as a trademark for phonograph records. Respondent opposed registration based, inter alia, on prior use of its trade name FORD on phonograph records. The CCPA merely applied the statute which states that a mark shall be refused registration if it "Consists of ... a mark which so resembles a ... trade name previously used in the U. S. by another and not abandoned, as to be likely when applied to the goods of the applicant, to cause confusion ... " 15 U.S.C. §1502(d).

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5 / STERN & GRESSMAN, SUPREME COURT PRACTICE §4.11, page 167 (Bur. Natl. Affairs, 1969); Rule 19.

Quite obviously the mark FORD for phonograph records so resembles respondent's trade name FORD previously used on phonograph records that confusion was likely. Here the issues are important only to the particular parties involved as distinguished from the public and hence are not "important" as interpreted by this Court as a requisite for the grant of a writ of certiorari. Rice v. Sioux City Cemetary, 349 U. S. 70, 79 (1955).

Petitioner's own statement of the "QUESTION PRESENTED" clearly shows that this is not a case involving principles, the settlement of which is "of importance to the public as distinguished from that of the parties" Layne & Bowler Corp. v. Western Well Works Inc., 261 U. S. 387, 393 (1923). The first and second parts of the petitioner's "question

presented" are answered by the statute relied upon which does not require prior registration or prior trademark use to refuse registration but specifies prior trade name use in the U. S. as a grounds for such refusal, 6 / a fact clearly present here. The third part of the question is irrelevant as pointed out by the CCPA decision, since petitioner's application to register FORD for phonograph records is not limited to "either the content or method of distribution and sale" 7 / so as to exclude respondent's previously used FORD training phonograph records.

This case does not involve a question

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6 / 15 U. S. C. §1502(d).

7 / CCPA decision, page 5, Appendix B to the petition.

of importance which is in the public interest to be decided by this Court of last resort. This Court does not and should not grant writs merely to give the defeated party in the court below another hearing. Magnum Co. v. Coty 262 U. S. 159, 163 (1923), Ferguson v. Moore-McCormack Lines Inc. 352 U. S. 521, 531 (1957), dissent of Frankfurter, J.

In short summary, there is nothing special or important about the CCPA decision and this Court in the exercise of sound judicial discretion should deny the petition for writ of certiorari.

Respectfully submitted,

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